

REMARKS

Reconsideration of this Application is respectfully requested in view of the foregoing amendment and the following remarks. Claims 16-21, 25-40, 42, 44, 46-56, 58, and 60-63 were pending in this Application. Claim 49 has been amended, and claims 27-34 remain withdrawn. Accordingly, claims 16-21, 25-26, 35-40, 42, 44, 46-56, 58, and 60-63 are presently under examination. Support for the amendments and new claims may be found, for example, in the original claims, and in the specification at page 30, line 9 through page 31, line 8. No new matter has been introduced by any of the requested amendments. For the reasons set forth below, Applicants respectfully submit that all claims pending herein are in condition for Allowance.

In the Office Action:

- Claims 16-20, 25-26, 35-40, 42, 49-53, 57-58, 61 and 63 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Rakib et al. (US 6,889,385; hereinafter "Rakib") in view of Kenner et al. (US 6,112,239; hereinafter "Kenner").
- Claims 21 and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Rakib and Kenner in view of Addington (US 6,928,656).
- Claims 44, 46-47, 60 and 62 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Rakib and Kenner in view of Nobakht et al. (US 6,813,639; hereinafter "Nobakht").
- Claims 48 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Rakib and Kenner in view of Nakamura et al. (US 5,913,039; hereinafter "Nakamura").
- Claim 55 is rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Rakib and Kenner in view of Pecus et al. (US 6,886,029; hereinafter "Pecus").

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Applicants respectfully traverse these rejections, for the reasons set forth below.

Addington Is Not Prior Art To The Present Application

As an initial matter, Applicants respectfully submit that Addington is not a proper reference to the present application pursuant to 35 U.S.C. § 103(c). Addington qualifies as prior art to the present application only under 35 U.S.C. § 102(e), and thus *cannot be used* to preclude the patentability of the present invention if it was, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. § 103(c); see also MPEP § 706.02(I)(2), Part II.

Applicants hereby submit that the present application and Addington were, at the time the claimed invention of the present application was made, owned by or subject to an obligation of assignment to the same person, i.e., Scientific-Atlanta, Inc. Evidence of common ownership includes the actual assignment of both patent documents to their common owner, Scientific-Atlanta, Inc., as evinced by the assignments recorded in the Office at Reel 009962, Frame 0262 (for Addington), and Reel 012260, Frame 0356 (for the present application).

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 21 and 54 over Rakib and Kenner in view of Addington, because the rejection has been obviated based on the disqualification of Addington as prior art.

Obviousness Rejection over Rakib in view of Kenner

Claims 16-20, 25-26, 35-40, 42, 49-53, 57-58, 61 and 63 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rakib in view of Kenner. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

Rakib Fails to Teach or Suggest the Claimed Invention

The presently claimed invention recites methods and systems for transmitting and/or receiving a dynamic network information table in a digital network, such as a digital subscriber

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network or a digital broadband delivery system, wherein the dynamic network information table includes: (a) information associated with transmission characteristics of a first device and one or more devices positioned upstream with respect to the first device (claims 16-21 and 25-26); or (b) information related to an identifier corresponding to an upstream device (claims 35-40, 42, 44, 46-56, 58, and 60-63). *See also* Application at page 32, line 26 through page 34, line 21.

The Office contends that Rakib teaches a method for enabling a receiver in a digital subscriber network to request services. Office Action at page 2. The Office further contends that Rakib teaches a “menu” corresponding to the claimed dynamic network information table, a “PID” corresponding to the claimed device-specific subtable, and a “PID that is associated with the sending node” corresponding to the claimed information associated with transmission characteristics of the first device, all at col. 9, line 41 through col. 10, line 22. Office Action at pages 2-3. Applicants respectfully disagree.

Contrary to the assertions in the Office Action, Rakib does not teach the claimed dynamic network information table, either in the cited columns or elsewhere. Rakib teaches “a menu to users of video programs, multimedia files, telephony services or wideband internet access or other wideband services which are available for selection by the user”, at col. 9, lines 50-55. This “menu” is not dynamic, nor does it contain information about network devices, as described and claimed in the present Application. Instead, Rakib teaches a menu containing information about programs and services, not devices. Rakib also fails to teach the transmission and/or receipt of any information related to network devices, let alone the transmission characteristics of a device or an identifier corresponding to an upstream device.

Moreover, nowhere in Rakib is it specified that the menu is dynamic. In the absence of any information about how the menu is presented to users, it is improper to conclude that Rakib teaches a dynamic menu, because a dynamic menu is not necessary to the operation of Rakib’s system. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17

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USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original), cited in MPEP § 2112 part IV. No such showing has been made here. Therefore, Rakib fails to teach the dynamic network information table limitation of claims 16-20, 25-26, 35-40, 42, 49-53, 57-58, 61 and 63.

Rakib also fails to teach a dynamic network information table including a device-specific subtable including information associated with transmission characteristics of the first device, as required by claims 16-21 and 25-26. The Office's comparison of the "PID" of Rakib to the claimed device-specific subtable fails, for the following reasons. Claim 16 and its dependent claims require the receiver (which also transmits requests for service) to receive a device-specific subtable including information associated with transmission characteristics of devices located upstream of the receiver. Rakib's Program Identifier Code (PID), however, is not received by the receiver from an upstream first device, and it does not include information about devices. Instead, Rakib teaches that the "cherry picker 10 also has an input ... for receiving upstream program and/or service requests from the users [and it] converts these requests for programs and services to program identifier codes (PIDs), IP source addresses or other identifying codes that can be used to cull out the data packets in the input streams that encode the requested programs and/or services", at col. 9, lines 32-67. Thus, not only does the PID of Rakib identify programs or services, not devices, but it is never sent to the receiver (e.g., the user's settop decoder). Therefore, Rakib fails to teach the device-specific subtable limitation of claims 16-21 and 25-26.

With respect to the Office's assertion regarding Rakib's alleged teaching of a "PID that is associated with the sending node", Applicants have not found disclosure of a sending node or an associated PID within Rakib, and respectfully request the Office to provide a column and line citation guiding them to this alleged teaching.

Kenner Fails to Teach or Suggest the Claimed Invention

The Office contends that Kenner teaches, at columns 18-20, a dynamic network information table including an upstream subtable. Office Action at page 3. The Office further contends that Kenner teaches an "upstream subtable including information associated with one or

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more devices positioned in the digital subscriber network upstream with respect to the first device.” *Id.* Applicants respectfully disagree.

Contrary to the assertions in the Office Action, Kenner does not teach the claimed dynamic network information table, either in the cited columns or elsewhere. Kenner teaches that a “correlation can be drawn between a user’s IP address and a delivery site that offers better data delivery performance”, and that the “correlated data is used to produce a look-up table”, at col. 16, lines 37-41. In particular, Kenner teaches that the “look-up table is formed comprising a list of first-byte IP addresses numbering 0-255, and for each address, a list of delivery sites providing improved performance for users having corresponding IP addresses”, at col. 17, lines 24-28, and that upon a user request, a “redirection server analyzes the user’s IP address and examines the list of potential delivery sites on the look-up table to determine what delivery site or sites are correlated with the user’s IP address”, at col. 18, lines 20-23. The system of Kenner may also “subdivide[] the look-up table into smaller sublists with a given range of addresses” and “download (step 142) to the user a small file containing the sublist”, at col. 18, line 62 through col. 19, line 1.

Kenner fails to teach or suggest the claimed invention. First, Kenner’s teaching of a static look-up table correlating IP addresses with preferred delivery sites is not a teaching or suggestion of a dynamic table, as required by all of the claims under examination. Second, Kenner’s look-up table fails to include any information about devices positioned upstream to the delivery sites, and thus fails to teach or suggest a dynamic table including information associated with transmission characteristics of one or more devices positioned upstream with respect to the first device, as required by claim 16 and its dependent claims. Third, Kenner fails to teach a method or system wherein a dynamic table including information related to an upstream device is transmitted to a device or apparatus, which adds information relating to itself before passing the table with the added information downstream, as required by claims 35 and 49, and their respective dependent claims. Therefore, Kenner fails to teach the dynamic network information table limitation of claims 16-20, 25-26, 35-40, 42, 49-53, 57-58, 61 and 63.

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For the reasons stated above, Kenner does not compensate for the deficiencies of Rakib. The cited references taken alone or in combination do not teach, suggest, or make obvious the dynamic network information table limitation of the present invention, and Applicant respectfully requests that the rejection be withdrawn.

Obviousness Rejection over Rakib and Kenner in view of Addington

Claims 21 and 54 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rakib and Kenner in view of Addington. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

As previously discussed, Rakib and Kenner are deficient as primary references, because they fail to teach or suggest each and every limitation of the independent claims, either alone or combined. Neither Rakib nor Kenner teach or suggest a dynamic network information table as claimed in the present invention. Moreover, because Addington has been disqualified as a prior art reference under 35 U.S.C. §103(c), as discussed above, it cannot be used to supplement the deficiencies of Rakib and Kenner as primary references. Hence, the cited references taken alone or in combination do not teach, suggest, or make obvious the present invention, and Applicants respectfully request that the rejection be withdrawn.

Obviousness Rejection over Rakib and Kenner in view of Nobakht

Claims 44, 46-47, 60 and 62 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rakib and Kenner in view of Nobakht. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

As previously discussed, Rakib and Kenner are deficient as primary references, because they fail to teach or suggest each and every limitation of the independent claims, either alone or combined. Neither Rakib nor Kenner teach or suggest a dynamic network information table as claimed in the present invention. Nobakht's alleged teaching of including network information

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in a program association table fails to supplement the deficiencies of Rakib and Kenner as primary references. Hence, the cited references taken alone or in combination do not teach, suggest, or make obvious the present invention, and Applicants respectfully request that the rejection be withdrawn.

Obviousness Rejection over Rakib and Kenner in view of Nakamura

Claims 48 and 56 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rakib and Kenner in view of Nakamura. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

As previously discussed, Rakib and Kenner are deficient as primary references, because they fail to teach or suggest each and every limitation of the independent claims, either alone or combined. Neither Rakib nor Kenner teach or suggest a dynamic network information table as claimed in the present invention. Nakamura's alleged teaching of a processor adapted to generate alert messages fails to supplement the deficiencies of Rakib and Kenner as primary references. Hence, the cited references taken alone or in combination do not teach, suggest, or make obvious the present invention, and Applicants respectfully request that the rejection be withdrawn.

Obviousness Rejection over Rakib and Kenner in view of Pecus

Claim 55 was rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rakib and Kenner in view of Pecus. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

As previously discussed, Rakib and Kenner are deficient as primary references, because they fail to teach or suggest each and every limitation of the independent claims, either alone or combined. Neither Rakib nor Kenner teach or suggest a dynamic network information table as claimed in the present invention. Pecus' alleged teaching of bit error information fails to supplement the deficiencies of Rakib and Kenner as primary references. Hence, the cited

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references taken alone or in combination do not teach, suggest, or make obvious the present invention, and Applicants respectfully request that the rejection be withdrawn.

In view of the foregoing, all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this Application in even better condition for issue, the Examiner is encouraged to telephone Applicants' undersigned representative.

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